

REMARKS

At the outset, Applicants request an interview to advance prosecution.

In the Office Action, the Examiner objected to the drawings; rejected claims 1, 4-8, and 11-14 under 35 U.S.C. § 112, second paragraph; rejected claims 8 and 11-13 under 35 U.S.C. § 112, first paragraph; objected to claims 1, 4-8, and 11-14; rejected claims 1, 5, 6, 8, 11-12, and 14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,104,929 to Josse et al. (Josse) in view of U.S. Patent No. 7,310,331 to Sjoblom; rejected claims 4 under 35 U.S.C. § 103(a) as being unpatentable over Josse, Sjoblom, in view of U.S. Patent No. 6,735,834 to Miettinen et al. (Miettinen); and rejected claims 7 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Josse, Sjoblom, in view of U.S. Patent No. 6,792,270 to Neumann.

By this amendment, Applicants amend claims 1 and 8 to more clearly define the features of those claim and cancel claim 14 without prejudice or disclaimer.

Claims 1, 4-8, and 11-13 are currently pending.

Regarding the drawings, Applicants submit herewith a replacement drawing for FIG. 1 (adding the label "Prior Art"). However, FIGS. 2-3 include features clearly not found in the prior art. For example, messages 2 and 6 at FIG. 2 are clearly not prior art messages as described in paragraphs 0053 and 0054. Therefore, the objections to the drawings should be withdrawn.

Regarding the rejection under 35 U.S.C. § 112, second paragraph, Applicants submit that the amendment made herewith obviate the basis of the rejection.

The Examiner rejected claims 8 and 11-13 under 35 U.S.C. § 112, first paragraph. Applicants traverse this rejection.

Claim 8 recites an apparatus comprising “a processor.” The Examiner alleges that the term “processor” invokes means plus function under 35 U.S.C. §112, sixth paragraph. Applicants disagree for at least the reason that the “processor” recites structure and, as such, makes it exceeding clear that claim 8 is not subject to a means plus function construction. Indeed, the Examiner’s position is a clear error in contravention of the law.¹ Therefore, the rejection under 35 U.S.C. § 112, first paragraph, of claim 8 as well as claims 11-13 at least by reason of their dependency should be withdrawn.

Regarding the objection to the use of “target” and “intercepted target,” Applicants have amended the pending claims to address the alleged confusion. Therefore, the objection should be withdrawn.

The Examiner rejected claims 1, 5, 6, 8, and 11-12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,104,929 to Josse et al. (Josse) in view of U.S. Patent No. 7,310,331 to Sjoblom.² Applicants respectfully traverse this rejection.

Claim 1 defines a method comprising:

¹ *Linear Technology Corp. v. Impala Linear Corp.*, 379 F.3d 1311, 1318, 72 USPQ2d 1065, 1069 (Fed. Cir. 2004) (“Whether claim language should be interpreted as a means-plus-function limitation under 35 U.S.C. § 112 ¶ 6 is a question of law.” – ruling that district court erred in construing claim limitations reciting a first circuit for monitoring a signal . . . , a second circuit for generating a first control signal . . . , and a third circuit for generating a second control signal . . .” as means-plus-function limitations because the claim limitations did not use the term “means,” and the recitation of the term “circuit” and the functional operation recited as being performed by the specific circuit connoted sufficient structure – vacating summary judgment of noninfringement due to errors in claim construction).

² Canceled claims have been omitted.

detecting a serving system node change request from a target towards a new serving system node which is currently not serving the target;

processing the serving system node change request at the new serving system node currently not serving the target, wherein the processing comprises the inclusion, to the serving system node change request, of a serving system address of the new serving system node currently not serving the target;

forwarding the processed serving system node change request to an old serving system node currently serving the target to enable the old serving system node to inform an interception system of the serving system address of the new serving system node currently not serving the target;

detecting whether there is at least one currently active communication context for the target at the new serving system node currently not serving the target;

generating, when there is at least one currently active communication context, a communication context update request including the serving system address of the new serving system node currently not serving the target; and

forwarding the generated communication context update request to a gateway serving system node of the serving system currently serving the target to enable the gateway serving system node to inform the interception system.

In some implementations of claim 1, the request message sent from the new SGSN to the old SGSN includes the serving system address of the new serving system node. As such, the old SGSN can directly inform an law enforcement system of this new information before the change. Applicants direct the Examiner to FIG. 2 at 2 and paragraph 0053. Moreover, the new SGSN checks whether there is a currently active context for the target, and if so, generates a context update request which is forwarded to the serving GGSN. Applicants direct the Examiner to FIG. 2 at 6 and paragraph 0054. As such, implementations consistent with claim 1 may address one or more past problems noted in the instant Background of the Invention.

Josse fails to recognize the above-noted problems. Thus, it is not surprising that Josse fails to disclose or suggest one or more features of claim 1. Josse discloses a data packet radio service with enhanced mobility management. Josse also discloses the use of an allegedly “new” GPRS Tunneling Protocol message to provide an update when a routing area update is sent by the mobile (e.g., during power up). Josse, col. 11, lines 21-43. Although Josse describes a protocol for inter-SGSN routing area updates (FIG. 4A), Josse is completely silent with respect to the protocol recited in claim 1, much less a protocol to inform an interception system of serving system information (e.g., the serving system address of the new serving system node) when roaming occurs. As such, Josse fails to disclose or suggest a protocol with double detecting, i.e., “detecting a serving system node change request from a target towards a new serving system node which is currently not serving the target,” and “detecting whether there is at least one currently active communication context for the target at the new serving system node currently not serving the target.” Indeed, Applicants note that the Examiner did not rebut Applicants previous allegations in the Remarks at pages 9 and 10. Moreover, the cited portions in Josse relied upon by the Examiner for Josse’s alleged detecting lack any mention of detection, much less detection of the aspects recited in claim 1.

Moreover, Sjoblom discloses a mechanism to order the packets in a system associated with a law enforcement intercept system. Although Sjoblom discloses that the law enforcement intercept system may be coupled to a GSN, Sjoblom suffers from the same deficiencies as Josse, i.e., offering no clue with respect to providing a protocol

to inform an interception system of serving system information, much less a protocol with double “detecting” as recited above in claim 1.

In view of the foregoing, neither Josse nor Sjoblom discloses or suggests at least the following features of claim 1: “detecting a serving system node change request from a target towards a new serving system node which is currently not serving the target,” and “detecting whether there is at least one currently active communication context for the target at the new serving system node currently not serving the target.” Therefore, claim 1 is allowable over Josse and Sjoblom, whether taken alone or in combination, and the rejection of claim 1 as well as claims 5 and 6, at least by reason of their dependency, under 35 U.S.C. § 103(a) should be withdrawn.

Because Josse and Sjoblom fails to disclose the double detecting noted above, Josse and Sjoblom cannot possibly disclose the corresponding forwarding and generating features, such as “forwarding the processed serving system node change request to an old serving system node currently serving the target to enable the old serving system node to inform an interception system of the serving system address of the new serving system node currently not serving the target;” “generating, when there is at least one currently active communication context, a communication context update request including the serving system address of the new serving system node currently not serving the target;” and “forwarding the generated communication context update request to a gateway serving system node of the serving system currently serving the target to enable the gateway serving system node to inform the interception system.” Therefore, claim 1 is allowable over Josse and Sjoblom, whether taken alone or in combination, and the rejection of claim 1 as well as claims as well as claims 5 and 6, at

least by reason of their dependency, under 35 U.S.C. § 103(a) should be withdrawn for this additional reason.

Independent claim 8, although of different scope, includes features similar to those noted above with respect to claim 1. For at least the reasons given above with respect to claim 1, claim is allowable over Josse and Sjoblom, whether taken alone or in combination, and the rejection under 35 U.S.C. § 103(a) of claim 8 as well as claims 11-12, at least by reason of their dependency, should be withdrawn for this additional reason.

Regarding the motivation to combine, the Examiner's modifications of Josse and Sjoblom fundamentally change the principal of operation of those references. For example, the Examiner is reconstructing Sjoblom, which relates to a very specific type of protocol as depicted and described with respect to FIG. 7. Indeed, the Sjoblom merely discloses a single GSN node. ***Therefore, Sjoblom cannot possibly be modified, as proposed by the Examiner, to operate in a system including an SGSN and a GGSN, which is the case in Josse's system.*** Thus, the Examiner's modification thus run afoul of M.P.E.P 2143.03 which states "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." Therefore, the rejection under 35 U.S.C. § 103(a) of rejected claims 1, 5, 6, 8, and 11-12 should be withdrawn for this additional reason.

The Examiner rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Josse, Sjoblom, in view of Miettinen. Applicants respectfully traverse this rejection.

Claim 4 depends from claim 1 and includes all of the features recited therein.

For at least the reasons noted above with respect to claim 1, claim 4 is allowable over Josse and Sjoblom. Moreover, although Miettinen discloses correlation numbers for lawful interception, Miettinen fails to cure the above-noted deficiencies of Josse and Sjoblom. Therefore, claim 4 is allowable over Josse, Sjoblom, and Miettinen, whether taken alone or in combination, and the rejection of claim 4 under 35 U.S.C. § 103(a) should be withdrawn.

The Examiner rejected claims 7 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Josse, Sjoblom, in view of Neumann. Applicants respectfully traverse this rejection.

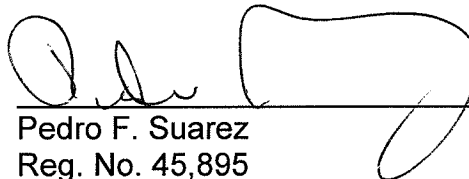
Claim 7 depends from claim 1 and includes all of the features recited therein. For at least the reasons noted above with respect to claim 1, claim 7 is allowable over Josse and Sjoblom. Claim 13, although of different scope, includes features similar to those of claim 7. Moreover, although Neumann discloses paging, it fails to cure the above-noted deficiencies of Josse and Sjoblom. Therefore, claim 7 and 13 are allowable over Josse, Sjoblom, and Neumann, whether taken alone or in combination, and the rejection of claim 4 under 35 U.S.C. § 103(a) should be withdrawn.

CONCLUSION

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant is concurrently filing herewith a Petition for a one-month extension of time with the requisite fee. Authorization for a credit-card payment of the filing fees mentioned above is submitted herewith. No additional fees are believed to be due, however the Commissioner is authorized to charge any additional fees or credit overpayments to Deposit Account No. 50-0311, reference No. 39700-582N01US/NC16997US. If there are any questions regarding this reply, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,


Pedro F. Suarez
Reg. No. 45,895

Date: 05 February 2010

Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
3580 Carmel Mountain Road, Suite 300
San Diego, CA 92130
Customer No. 64046
Tel.: (858) 314-1540 Fax: (858) 314-1501